



Atty. Dkt. No. 033730-0102
In re PTA of Patent No. 7,799,280

PAC #
JPN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Henricus Petrus Joseph TE RIELE, et al.

Title: HOMOLOGOUS RECOMBINATION IN
MISMATCH REPAIR INACTIVATED
EUKARYOTIC CELLS

Appl. No.: 09/884,877

Filing Date: 6/20/2001

Patent No.: 7,199,280

Issued: 4/3/2007

Examiner: SGAGIAS, MAGDALENE K.

Art Unit: 1632

Conf. No.: 3654

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(d)

MS Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 1.705(d), Patentee requests reconsideration of patent term adjustment. Applicants (for PTA) are in receipt of the above-referenced patent. However, Applicants disagree with the Determination of Patent Term Adjustment under 35 USC § 154(b) and present the following facts to support the contention that the patent term reward should be 203 days instead of 0 (zero) days as indicated on the front face of the patent.

The Facts begin on the next page.

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I. Facts

A. General Information

1. U.S. Application no. 09/884,877 was filed under 35 U.S.C. § 111(a) on 06-20-2001.
2. Under 35 U.S.C. § 154(b), the '877 application is eligible for Adjustments of Patent Term (PTA).
3. The '877 application issued as U.S. Patent No. 7,199,280 on 04-03-2007.
4. This request is being filed within the two-month window allowed under 37 C.F.R. § 1.705(d) and is therefore a timely filed request.
5. Under 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) (\$200) is being filed with this request.
6. Under 37 C.F.R. § 1.705(b)(1)(ii), relevant dates, with emphasis (bold,¹ dashes,² numbers and subsections) on important items, are as follows:

Table 1. Relevant Dates

Date	Event	Days since actual filing date	Rule 702(a)(x) ³	Rule 702(b)	Rule 704
06-20-2001	Application Filed under 35 U.S.C. § 111(a)	0			
07-24-2001	Notice to file missing parts	34			
10-24-2001	Three months after notice to file missing parts	126			

¹ Identifies a particular paper.

² Identifies the start of a period.

³ When (x) is (2), e.g., the Rule is 702(a)(2).

12-26-2001	Reply To Notice to file missing parts	189			(-0) ⁴
01-14-2002	<u>Withdraw Notice to file missing parts of 07-24-2001</u> and Mail Corrected Notice to file missing parts	208			
04-14-2002	Three months after Corrected Notice to file missing parts	298			--
04-15-2002	Reply to Corrected Notice to file missing parts	299			(-1)
08-20-2002	14 months from filing	426	--		
10-01-2002	Restriction requirement	468	(1) 42		
10-31-2002	Response to Restriction requirement	498			
02-04-2003	Office action	594			
05-04-2003	Three months after Office action	683			--
08-04-2003	Response to Office action	775			
08-13-2003	Notice of noncompliant amendment	784			

⁴ The Notice to file Missing parts was withdrawn in the paper mailed 01-14-2002.

09-08-2003	Response to Notice of noncompliant amendment	810			
01-02-2004	Second Notice of noncompliant amendment	926			
01-12-2004	Reply to Second Notice of non-compliant amendment	936			(-253)
04-16-2004	Office action	1031			
07-16-2004	Three months after Office action	1122			--
06-20-2004	Three years after filing	1096		--	
10-14-2004	Response to Office action	1212			(-90)
12-23-2004	Final Office action	1282			
03-23-2005	Three months after final Office action	1372			--
04-22-2005	Response to Final Office action	1402			
05-23-2005	Advisory action	1433			
05-27-2005	Second Reply after final	1437			
06-23-2005	Advisory action & Notice of Appeal	1464			(-92)

01-18-2006	RCE with Substantive submission	1673		577	
04-10-2006	Ex parte Quayle	1755			
05-08-2006	Response to Ex parte Quayle	1783			
09-08-2006	Notice of allowance	1906			
11-14-2006	Issue Fee paid	1973			
01-12-2007	Examiner's Amendment	2032			
03-14-2007	Four months after issue fee is paid	2093	--		
04-03-2007	Patent Issues	2113	(4) 20		
		Totals	62	577	(-436)

7. Under 37 C.F.R. § 1.705(b)(iii), the '280 patent is not subject to a terminal disclaimer.
8. 37 C.F.R. § 1.705(b)(iv)(A) statement: Patentee submits that the Reply to the Corrected Notice to file missing parts, filed on 04-15-2002, was filed 1 day beyond the three-month period. Patentee submits that an amendment in response to the 02-04-2003 Office action (including responses to non-Compliant notices) was filed 253 days after the three-month period. Patentee submits that an amendment in response to the 04-16-2004 Office action, was filed 90 days after the three-month period. Patentee submits that a Notice of Appeal of the decision in the 12-23-2004 Office action was filed 92 days after the three-

month period. Summing these periods, (1+253+90+92 days), the admitted delay is (-436) days.

9. The undersigned has studied the PAIR report for the PTA and has concluded the following:

- (a) 42 days, attributable to PTO delay between the period from when the application was filed (06-20-2001) and from when the first Office action was mailed (10-01-2001) under Rule 702(a)(1) is not in dispute;
- (b) 20 days, attributable to PTO delay between the period from when the issue fee was paid (11-14-2006) and from when the patent issued (04-03-2007) under Rule 702(a)(4) is not in dispute;
- (c) (-436) days, attributable to Applicants' admitted delay (see above) is not in dispute;
- (d) (-173) days, attributable to Applicants' delay between the period from when the withdrawn Notice to file missing parts was mailed (07-24-2001) and from the reply (12-26-2001) was filed is in dispute; and
- (e) 577 days, the delay period of PTO delay under Rule 702(b) (17 year guarantee) is in dispute.

10. Items (d) and (e) of the previous paragraph are the subject matter bases for the Request for Reconsideration.

II. **Bases for Reconsideration of PTA under Rule 705(d)**

11. There are two regulatory bases for reconsideration, namely, 37 C.F.R. § 1.704 and 37 C.F.R. § 1.702(b).

A. First Basis for Reconsideration of items relevant to PTA under 37 C.F.R. § 1.704

Attention is drawn to the PTO's indication in PAIR of the 173 day delay attributed to Applicants, which period begins with the July 24, 2001, mailing of a Notice to File Missing Parts, and ends with the April 15, 2002, filing of a technically good sequence listing. Although Applicants responded to the Notice to File Missing Parts on December 26, 2001, (i.e., 63 days after three months), the PTO withdrew the Notice to File Missing Parts of July

24, 2001. Thus, because there can be no delay for a withdrawn Notice, the period of delay starting with the Notice mailed July 24, 2001, is irrelevant.

Applicants then received a Withdrawal of Previously Sent Notice and corrected Notice to Comply, both of which were mailed on January 14, 2002. The Withdrawal of Previously Sent Notice indicates "The time period for reply runs from the mail date of the corrected Notice," i.e., January 14, 2002. Applicants filed a complete Response to the Notice to Comply and a petition for one month extension of time on April 15, 2002. According to our calculation, Applicant delay for this event is 1 day.

In view of the above, the 173 days of delay as shown in the PTO records is incorrect, the total Applicant delay for these events should be 1 day.

B. Second Basis for Reconsideration of items relevant to PTA under 37 C.F.R. § 1.702(b)

12. The PTO failed to properly calculate the adjustments due under Rule 703(b).
13. Under Rule 703(b), the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) is 06-20-2004.
14. Under Rule 703(b), the date that the patent issued is 04-03-2007.
15. 1017 days is the period of the previous two items.
16. Under Rule 703(b)(2), (3), and (4), no adjustments are needed.
17. Under Rule 703(b)(1), the period after the RCE filed 01-18-2006 and patent issuance is 440 days.
18. 577 days is the total period of adjustment under Rule 702(b) -- that is, $1017 - 440 = 577$.

III. Conclusion

Correct Patent Term Adjustment: in view of the foregoing, Patentee respectfully requests the PTO to correctly award 203 days of PTA. The calculation is shown below:

- (a) 42 days, attributable to PTO delay between the period from when the application was filed (06-20-2001) and from when the first Office action was mailed (10-01-2001) under Rule 702(a)(1);

(b) 20 days, attributable to PTO delay between the period from when the issue fee was paid (11-14-2006) and from when the patent issued (04-03-2007) under Rule 702(a)(4);

(c) (-436) days, attributable to Applicants' admitted delay (see above);

(d) (0) days, attributable to Applicants' delay between the period from when the withdrawn Notice to file missing parts was mailed (07-24-2001) and from when the reply was filed (12-26-2001); and

(e) 577 days, the period of the PTO's delay under Rule 702(b) (17 year guarantee).

203 days of total PTA: this was determined by summing the periods A+B+C+D+E days "to the extent that such periods are not overlapping" as defined under Rule 703(f), (see Table 1).

Taking into consideration the above corrections, the total PTO delay is 639 days, and the total Applicant day is 436 days, resulting in the correct patent term adjustment of 203 days.

19. The deciding official is invited to contact the undersigned with questions regarding this Request for Reconsideration.

20. The PTO is asked for the just, speedy, and inexpensive disposition of this Request for Reconsideration, including correcting any inadvertent math errors, making adjustments based on either basis for reconsideration should one basis be not granted, and making other just and fair determinations.

Enclosed with this request is the fee of \$200.00 as set forth in 37 C.F.R. §1.18(e). Furthermore, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

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Respectfully submitted,

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